

### **Remarks**

Claims 3, 13, 23, 30, and 37 have been canceled. Claims 1, 11, 21, 28 and 35 have been amended with the additional limitation, "wherein said intermediate pressure steam has a pressure in the range from about 50 psig to about 260 psig" added. Supported for this limitation can be found on page 15 lines 1-4 of the disclosure.

### **Claim Rejections – First Paragraph of 35 U.S.C. 112**

Claims 1, 3-11, 13-21, 23-28, 30-35 were rejected under 35 U.S.C 112, first paragraph. More specifically, the examiner stated that "a low pressure stream" expression is vague and indefinite. Applicants respectfully disagree with this assertion as the low pressure stream is defined in the specification and is lower than the intermediate pressure stream. In order to advanced prosecution, the addition limitation for the intermediate pressure steam has been added to all the independent claims. Therefore, the recompression ranged had been defined.

Therefore, in view of the above arguments and amendments made, Applicants respectfully state that the 35 U.S.C. 112 paragraph 1 rejections should be withdrawn.

### **Rejections under 35 U.S.C. § 103**

Claims 1-44 were rejected under 35 U.S.C 103 as being unpatentable over Graham et al. (WO 02/06201A1) (hereinafter "Graham").

To establish a *prima facie* case of obviousness based on a single prior art reference, the examiner must demonstrate that (1) the reference teaches or suggests all the claim limitations, (2) the reference, coupled with the knowledge generally available in the art at the time of the invention, contains some suggestion or motivation to modify the teachings of the reference, and (3) the

proposed modification would have had a reasonable expectation of success, determined from the vantage point of a skilled artisan at the time the invention was made. MPEP § 2142.

Applicants again wish to thank the examiner for his time and attention in the interview conducted on 12/13/2006. The following remarks are respectfully submitted. Graham fails to teach all the limitations of the amended claims for at least the following reasons. For example, Graham does not teach steam recompression. No where in Graham is steam being compressed from a low pressure steam to an intermediate steam. Graham is a traditional steam process that is known in the art. For example, the Examiner writes that "the heat-accepting fluid can be used to high pressure steam which can be superheated by external heat and fed a high efficiency condensing steam turbine to recover power".

This steam recovery process in Graham is a standard power cycle known in the art, that involves making steam from water, superheating the steam, and then recovering the power in the steam via a turbine. However, Applicants' process is different in that steam is actually being recompressed from low pressure to a higher pressure.

One may be inclined to say that Graham could be modified to disclose Applicants' invention. However, the MPEP is clear that this would not meet the standard of obviousness. The mere fact that a prior art reference *can* be modified does not render the resultant modification obvious unless the prior art also suggests the *desirability* of the modification. MPEP § 2143.01(III). The Examiner bears the burden of providing the suggestion of the desirability of doing what the inventor has done. MPEP 2143.01. There are three possible sources for a motivation to modify the teachings of a reference: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. MPEP § 2143.01(I). If the motivation for making the proposed modification is not immediately apparent from the teachings of the prior art, it is the duty of the Examiner to present a convincing line of reasoning

explaining why modification of the teachings is proper. MPEP § 2142. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

One might also be inclined to state that it would be obvious to try different parameters and setups in Graham to obtain Applicants' invention. However, again this would not meet the criteria for obviousness.

"Obvious to try" is not the appropriate standard under § 103. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Thus, it is inappropriate for an Examiner to assert that it would have been obvious to try varying all parameters or obvious to try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.

MPEP § 2145. In order for the Examiner to properly rely on "optimization through routine experimentation" as a basis for motivating one to modify a parameter taught in the prior art, the Examiner must first establish that the modified parameter would be recognized as a result-effective variable (i.e., a variable which achieves a recognized result). MPEP § 2144.05(II)(B).

Applicants' respectfully state that Graham does not provide any motivation for the nonobvious improvements in Applicants' invention. Therefore, it is respectfully requested that in view of the amended claims that the obviousness rejection be removed.

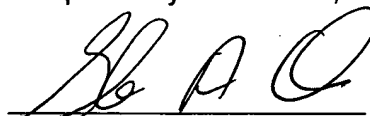
### Conclusion

The application is in condition for allowance. The Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

Eastman Chemical Company  
P.O. Box 511  
Kingsport, Tennessee 37662

Phone: (423) 229-5534  
FAX: (423) 229-1239

Respectfully submitted,

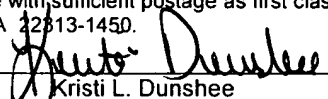


Steven A. Owen  
Registration No. 50,355

2/15/2007  
Date

#### CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
\_\_\_\_\_  
Kristi L. Dunshee

2-16-07  
\_\_\_\_\_  
Date